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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/595,528	06/16/2000	Scott E. Landau	IFF-101	2190

7590 02/26/2003

Barry R Lipsitz  
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EXAMINER

RUDY, ANDREW J

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 02/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



# Office Action Summary

Application No.

09/595,528

Applicant(s)

LANDAU ET AL.

Examiner

Andrew Joseph Rudy

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) 28-54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-54 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.



### **DETAILED ACTION**

1. Claims 1-54 are pending.

#### ***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-27, drawn to a method for providing e-commerce, classified in class 705, subclass 26.
  - II. Claims 28-54, drawn to a system for providing e-commerce, classified in class 705, subclass 30.

3. Inventions Group II and Group I are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because a transaction server is not required in Group I. The subcombination has separate utility such as using it as a method of providing a database for lost and missing animals of various categories or breeds located in various locations, e.g. an animal shelter, and charging a fee for such a service.



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4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Barry Pipsitz (Reg. No. 28,637) on February 7, 2003 a provisional election was made with traverse to prosecute the invention of Group, claims 1-27. Affirmation of this election must be made by applicant in replying to this Office action. Claims 28-54 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.



For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claim 1 only recites an abstract idea. The recited steps of providing an intermediary, enabling members to select, storing billing information at the intermediary and providing a consolidated invoice does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. In the instant case the method steps may be conducted by mind/hand and adapted for e-commerce use. Applicant's intended claim language, e.g. "for providing," "to allow" from claim 1, does not positively recite claim language that falls within the technological arts. Applicant's attempt to positively recite limitations that are merely intended use, e.g. claim 5, do not cure the original deficiency.

### ***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.



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9. Claims 1-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, line 3, the phrase "e-commerce" should be clearly defined.

Claim 1, line 3, the phrase "the organization" lacks antecedent basis and is not clear which of the plurality of "organizations" from line 2 is being referenced, nor with "an organization" from line 7.

Claim 1, line 3, the phrase "the service provider" lacks antecedent basis and is not clear which of the plurality of "service providers" from line 2 is being referenced.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hodroff, US 5,687,323.



Hodroff in Figs. 2A and 3 discloses an e-commerce system providing accounting and product information comprising an intermediary, e.g. Currency Exchange Computer Verification Network, e.g. see cols. 5-9. To provide the businesses, employees and consumers to be members of an organization, as understood, would have been obvious to one of ordinary skill in the art. Doing such would use well known mailing/organizational lists used to conduct commerce. The particular data stored/used, e.g. billing information data and/or report generated, would have been obvious to one of ordinary skill in the art. Official Notice is taken that information of this kind is extremely well known in the business accounting commerce art. To have used such would be merely implementing well known data entry/verification used within ordinary commerce operations.

11. Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilf et al., US 5,899,980.

Wilf, e.g. Fig. 1, discloses an e-commerce system providing accounting and product information comprising an intermediary, e.g. STSP 20, where customer computer stations may access inventory. Billing is executed such that an inventory of products purchased may be stored and commissions may be parsed out to a third party. To provide the businesses, employees and consumers to be members of an organization, as understood, would have been obvious to one of ordinary skill in the art. Doing such would use well known mailing/organizational lists used to conduct commerce. The particular data stored/used, e.g. billing information data and/or report



generated, would have been obvious to one of ordinary skill in the art. Official Notice is taken that information of this kind is extremely well known in the business accounting commerce art. To have used such would be merely implementing well known data entry/verification used within ordinary commerce operations.

12. Further pertinent references of interest:

Dimattina, US 6,405,177, discloses accounting commerce data, e.g. cols. 5, 6.

Franklin et al., US 6,125,352, discloses a commerce purchasing system.

Neely, US 6,044,362, discloses an intermediary accounting terminal.

Hill, US 5,970,471, discloses a virtual product purchasing system.

Kolling et al., US 5,963,925, discloses an electronic accounting data system.

13. Applicant's Information Disclosure Statement (IDS) received January 10, 2002 has been reviewed. Note attached PTO-1449.

14. Applicant's Information Disclosure Statement (IDS) received September 29, 2000 has been reviewed. However, references designated AG and AH were not reviewed as each does not constitute prior art. Note attached PTO-1449.



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***Conclusion***

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Joseph Rudy whose telephone number is 703-308-7808. The examiner can normally be reached on Tuesday thru Friday, 7:30 a.m until 6 p.m..

If attempts to reach the examiner by telephone are unsuccessful, Mr. Richard Chilcot, may be reached on 703-305-4716. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

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February 13, 2003

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3600